



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inter patent application of:

AKIYAMA

Conf. No.: 9695

Application No. 09/782,220

Art Unit: 2625

Filed: February 14, 2001

Examiner: T. Pham

For: **PRINTER DRIVER FOR SETTING STENCIL PRINTING MACHINE
PRINTING CONDITION ITEMS AND THE LIKE**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

Sir:

Applicant appeals the final rejection in the Office Action of March 13, 2007 (hereinafter, "the March 13 Action") of claims 1, 2, and 3 under 35 U.S.C. §103(a) as being unpatentable over applicant's admitted prior art (AAPA) and U.S. Patent No. 6,181,436 to Kurachi (hereinafter, "Kurachi") in view of U.S. Patent No. 5,671,669 to Okuda et al. (hereinafter, "Okuda").

No amendments are being filed with this Request. Further, this Request is being filed with a Notice of Appeal. The review is requested for the reasons stated herein.

I. The rejection of claim 3 under 35 U.S.C. §103(a) is incomplete and improper

Applicants submit that the Examiner has ignored the features of presently pending claim 3, and thus has failed to make a *prima facie* case of obviousness thereto. This claim was introduced in the response of January 9, 2007 as an attempt to reduce confusion over the term "secret keeping operation," as will be discussed below. The Examiner did not address this new claim in formulating his rejection of March 13, 2007, and thus this claim has never been given proper consideration. From page 2, line 16 of the outstanding Office Action, which notably begins "[r]egarding claims 1-

2”, to the end of the Office Action, the Examiner makes no mention whatsoever of claim 3, or of its particular features. Applicants appeal the Examiner’s final rejection of claim 3, and demand that the Examiner either allow the claim or address its features in a proper rejection, including the newly-phrased feature of a “printer driver [that] automatically instructs [a] stencil printing machine to remove a used stencil sheet from a print drum and dispose of said used stencil sheet.”

II. The rejection of claims 1 and 2 under 35 U.S.C. §103(a) is improper because the cited prior art does not teach all of the claim limitations.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

The Examiner’s rejection of claims 1 and 2 is improper since the Examiner has failed to indicate where the cited prior art discloses, teaches, or suggests the feature of a “secret keeping operation...instructing [a] stencil printing machine to remove a used stencil sheet from a print drum and dispose of [the] used stencil sheet after [a selected] number of copies have been printed.”

In formulating a rejection under 35 U.S.C. §103(a), the Examiner has asserted that:

- applicant’s admitted prior art (AAPA) teaches a printer driver provided at a host computer while said host computer is connected to a stencil printer (the March 13 action, page 2);
- Kurachi teaches that a “secret operation settings” can be incorporated into a printer driver (the March 13 action, page 3); and
- Okuda teaches an example of removing a used stencil sheet from a print drum and disposing of the used stencil sheet after the print job has been printed (the March 13 action, page 3).

The Examiner asserts that it would be obvious to modify the printed driver of AAPA to include the “secret operations setting” of Kurachi for various reasons: to allow operators to control

printer features remotely, to keep confidential print data secure from intruders, and to prevent operator error (the March 13 action, page 3). The Examiner further asserts that it would be obvious to modify a conventional stencil printing device to include the “stencil discharge section” of Okuda to prevent unauthorized users from viewing confidential data. (the March 13 action, pages 3 and 4).

Therefore, the Examiner’s case of obviousness with respect to claims 1 and 2 rests on the combination of an AAPA printer driver with a Kurachi “secret operations setting,” and of an AAPA stencil printing device with an Okuda “stencil discharge section.” This combination is insufficient. The Examiner has not shown that Kurachi teaches or suggests the claimed “secret keeping operation.”

Although the “secret operation settings” of Kurachi is similar in name to the presently claimed “secret keeping operation,” the two perform entirely different functions in entirely different manners. The “secret operation setting” of Kurachi causes a computer and connected printer to encrypt print data and withhold potentially revealing print job information; that is, it defines how *data* is to be handled *before and during printing*. In the “secret operation setting” of Kurachi, when “secret setting information...is sent from one of the client apparatuses to the printing apparatus, the print job information sending device of the printing apparatus does not send the print job information to other client apparatus” (Kurachi, column 5, lines 4-10). This “print job information” is composed of “management information of the print job and a rough image correlated with the print data corresponding to the Print job” (Kurachi, Summary of the Invention, Column 2 lines 29-31).

In contradistinction, the presently claimed “secret keeping operation” instructs a printing machine to remove a used stencil sheet from a print drum and dispose of the used stencil sheet after a selected number of copies have been printed; that is, it commands a printer to perform a *mechanical step after printing is completed*. The Examiner has further failed to show why and how the presence of “secret operation settings” in Kurachi would motivate one of skill in the art to create a printer driver having a “secret keeping operation” of the kind so claimed.

The above arguments have been presented in greater detail in the responses of January 9, 2007 (see pages 7 and 8), October 6, 2006 (see page 6, and note the corresponding claim amendments presented therein), and June 27, 2006 (see pages 6 and 7). The Examiners are referred to these responses to review the distinctions between the “secret operations settings” of Kurachi, and

the “secret keeping operation” of the present disclosure. Applicants note that, despite repeated amendments to these claims in an attempt to positively define a secret keeping operation which is clearly different from the “secret operation setting” of Kurachi, the Examiner has unreasonably maintained the same essential rejection since November of 2005.

Therefore, as the cited prior art does not disclose, teach, or suggest a “secret keeping operation” as claimed in claims 1 and 2, the Examiner has filed to make a *prima facie* case thereto. By this appeal, withdrawal of these rejections is requested.

III. The rejection of claims 1 and 2 under 35 U.S.C. §103(a) is further improper because the Examiner has applied impermissible hindsight in combining the “secret operation setting” of Kurachi with the “stencil discharge section” of Okuda.

In considering the present application, the Examiner has repeatedly ignored the required tenets for applying 35 USC 103, as set out in the MPEP at section 2141. See *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). As set forth in the Response of January 9, 2007, the Examiner fails to consider the claimed invention as a whole and applies impermissible hindsight. Specifically, the Examiner has failed to show why *each necessary* combination of prior art features would be obvious to one of ordinary skill in the art.

Present claims 1 and 2 clearly set forth a “secret keeping operation” at a printer driver, which “instruct[s a] stencil printing machine to remove a used stencil sheet from a print drum and dispose of [the] used stencil sheet after [a selected] number of copies have been printed,.” The Examiner has thus far not located this feature in the prior art. Instead, the Examiner has attempted to show why it would be obvious to add “secret operation settings” to a printer driver, and a “stencil discharge section” to a printer.

Even if *arguendo* the “secret operation setting” or Kurachi is equated with the presently claimed “secret keeping operation,” *and* even if *arguendo* it would be obvious to add a secret keeping operation to a printer driver and a stencil discharge section to a printer, *the Examiner has not shown why it would purportedly be obvious to combine such a settings-enhanced driver with such a stencil discharge section-enhanced printer.* The Examiner’s formulated rejection is not logically

sufficient to reject the claimed feature of a "secret keeping operation" disposed in a printer driver and "instructing [a] stencil printing machine to remove a used stencil sheet from a print drum and dispose of [the] used stencil sheet after [a selected] number of copies have been printed." Instead, the Examiner has connected his cited prior art features through the use of impermissible hindsight.

Therefore, as the Examiner has shown no motivation to combine a printer driver with a secret keeping operation which *specifically* instructs a stencil printing machine to perform a stencil sheet removal as claimed in claims 1 and 2, the Examiner has further failed to make a *prima facie* case thereto. By this appeal, withdrawal of these rejections is requested.

CONCLUSION

For the aforementioned reasons, the rejections of record are clearly improper and as such, should be immediately withdrawn. Accordingly, applicant requests that the USPTO reconsider and withdraw these rejections.

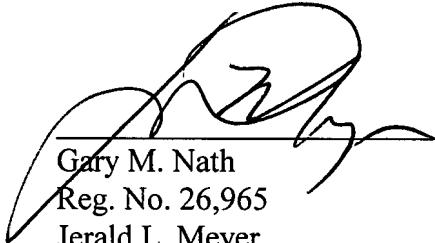
If the Examiners have any questions or wishes to discuss this matter, they are welcomed to telephone the undersigned attorney.

Respectfully submitted,
THE NATH LAW GROUP

Date: June 8, 2007

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